REMARKS

Claim Status

Claims 1 - 14 are pending in the present application. No additional claims fee is believed to be due.

Claims 15-21 are canceled without prejudice.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §103(a) Over Yajima in view of Hefele and Buell

Claims 1, 2, 3, and 11, are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,343,260 issued to Yajima et al., hereafter, "Yajima", in view of U.S. Patent No. 4,141,313 issued to Hefele, hereafter, "Hefele I", and in view of U.S. Patent No. 4,147,580 issued to Buell, hereafter, "Buell". Applicants respectfully traverse the rejection by the Office.

It is well settled that in order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.*

First, Applicants respectfully traverse the rejection by the Office because the proposed modification of Yajima is not sufficient to render the claims *prima facie* obvious. Case law provides that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). In this case, the court reversed an obviousness rejection and held that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic

principle under which the [primary reference] construction was designed to operate." *Id.* (citing 270 F.2d at 813, 123 USPQ at 352).

Yajima teaches an apparatus for "applying a liquid to a cloth or the like including a stamp roll having a peripheral surface provided with a pattern of pits." (Abstract). Yajima further teaches that "[a] material in liquid state is supplied from a supply container 5 to the rubbing block 4 through which the liquid material is fed into the individual pits 1." (col. 1, lines 40-42). Applicants note that Yajima makes several other references to the applied material being in a liquid state. (See col. 2, lines 12-14; lines 17-24; lines 39-42; and lines 58-60).

Hefele I teaches "[a] process and apparatus for the patterned deposition of powdered thermoplastics adhesive material on the outer surface of a textile." (Abstract). However, in contrast to Yajima, Hefele I teaches that an adhesive powder is raked "in a pattern of depressions formed in an engraved component" and "then on this powder a further adhesive powder is insertion raked in the depressions." (Abstract). Applicants were unable to find any teaching in Hefele I which referred to a liquid material being applied to the depressions.

Because Yajima teaches the use of an adhesive in the liquefied state and Hefele teaches the use of an adhesive in a powdered state, the proposed modification by the Office would change the principle operation of the process taught by Yajima. Namely, the process of Yajima would have to be modified such that adhesive could be applied in a powder form instead of in liquefied form. Consequently, Applicants assert that the proposed modification to Yajima would change the principle operation of Yajima. Therefore, Applicants assert that the proposed modification is not sufficient to establish a *prima facie* case of obviousness.

Second, Applicants respectfully traverse the rejection by the Office because the proposed modification would render the modified reference unsatisfactory for its intended purpose. Case law provides that "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Yajima states that "[a]n object of the present invention is to provide an apparatus for applying a liquid state material onto a surface of a cloth or the like by which the liquid

can be uniformly and continuously applied in dot pattern." (col. 1, lines 16-20). In contrast, as stated previously, Hefele I teaches the application of an adhesive powder to an engraved roll. Hefele I teaches that the engraved roll is at a lower temperature than the melting point of the adhesive powder. (See Example 1, col. 8, lines 8-24; col. 8 line 65 through col. 9 line 6). Additionally, Hefele I teaches that "[i]n the course of further rotation of the engraved roller the powder coatings 27, 28 then become adhered to this surface form." (col. 6, lines 51-53). Thus, instead of the application of a liquid state material onto a surface, Hefele I teaches the application of a powder to a surface. Because, Hefele I teaches the application of a powder to the surface as opposed to a liquid, Hefele I contradicts the purpose of Yajima. Accordingly, Applicants assert that there is no motivation to combine the suggested references.

Third, there is no motivation to combine Hefele I and Buell. In its rejection, the Office states that "[i]t would have been obvious for Hefele to heat the adhesive applicators to an application temperature Buell had taught because one would have been motivated to have an adhesive of appropriate temperature, flow, and adhesive characteristics for coating a porous, fibrous web." However, Hefele I teaches away from such a modification.

As stated previously, Hefele I teaches "[a] process and apparatus for the patterned deposition of powdered thermoplastics adhesive material on the outer surface of a textile." (Abstract). Hefele I further teaches that "[s]ince the take-off roller 5 is usually heated, the side wall 12 of the powder container 10 which lies adjacent the roller 5 is provided with a water cooling arrangement 17. In this way heat radiating from the roller 5 is kept away from the inside of the powder container 10." (col. 5, lines 55-59).

Because Hefele I teaches that heat should be kept away from the powder container 10, one of ordinary skill in the art would be dissuaded from heating the powdered adhesive of Hefele I despite the teachings of Buell. As such, there is no motivation to combine Hefele I with Buell.

Fourth, the suggested combination of references fails to teach all of the claim elements of the present invention. Claim 1 recites, in part, that the active material is applied "to a surface of a first tool in the form of a multitude of beads... with a coater unit having a multitude of applicators." Similarly, claim 2 recites, in part, that the active material "is applied in the form of a multitude of beads with a coater having a multitude

of applicators." As shown in Figure 1B, the multitude of beads and the multitude of applicators are spaced apart along the width of the first tool.

In contrast, Yajima teaches a rubbing block 4 having a single liquid supply passage 11. (See col. 2, lines 8-10; Figures 1-4). Additionally, while Hefele I teaches two separate powder containers, i.e. 10 and 11 which are spaced about the circumference of engraved roller 1, Hefele I is silent with regard to the application of the powder as a multitude of beads. Additionally, Hefele I is silent with regard to the multitude of applicators which are spaced apart along the length of the first tool. Consequently, the suggested combination fails to teach or suggest all of the claim elements of claim 1.

For the foregoing reasons, Applicants assert that the Office has failed to establish a *prima facie* case of obviousness against claims 1 and 2. Additionally, at least for the reasons stated above and because claims 3 and 11 depend from claim 1, Applicants assert that the Office has failed to establish a *prima facie* case of obviousness against claims 3 and 11. Accordingly, Applicants assert that claims 1, 2, 3, and 11, are patentable over the suggested combination of references.

Rejection Under 35 USC §103(a) Over Yajima, Hefele I, Buell, Lender, and Friesch

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yajima in view of Hefele I, in view of Buell, in further view of EP Patent Application No. 0978263 filed on behalf of Lender et al., hereafter, "Lender", and in further view of U.S. Patent No. 5,064,492 issued to Friesch, hereafter, "Friesch". Applicants respectfully traverse the rejection by the Office.

First, Applicants assert that there is no motivation to combine Yajima and Hefele I. For all of the reasons provided above, with regard to the rejection of claims 1, 2, 3, and 11, there is no motivation to combine Yajima and Hefele I. Additionally, for the reasons presented above, with regard to claims 1, 2, 3, and 11, there is no motivation to combine Hefele I with Buell.

Second, Applicants assert that there is no motivation to combine Lender with Hefele I. In its rejection, the Office states:

> Even though Buell teaches applying a coating at a heated temperature, the difference between Yajima et al. in view of Hefele and Buell and claim 4 is the method of heating the coater and the engraved roller and cooling the

> pressure take-off roller. Lender et al. teaches to keep the coater and engraving roller at a high temperature and Friesch teaches the cooling of the adhesive after imprinting on the substrate.

(Office Action page 6).

However, as stated previously, Hefele I teaches that cooling arrangements are provided for the powder containers so as to keep heat from the roller away from the inside of the powder container. As such, Hefele I teaches away from any suggestion to heat the coater. For this reason, one of ordinary skill in the art would be dissuaded from combining the teachings of Lender and Hefele I

Third, there is no motivation to combine Friesch with Hefele I. Friesch, similar to Lender, teaches that "a film 122 has permanently imprinted thereon at elevated temperatures a patterned array of adhesive." (col. 3, lines 52-54). Friesch teaches the application of adhesive at elevated temperatures. In contrast, as stated previously, Hefele I teaches that heat should be kept away from the adhesive powder containers. As such, one of ordinary skill in the art would be dissuaded from combining the teachings of Friesch and Hefele I.

For the foregoing reasons Applicants assert that a *prima facie* case of obviousness has not been established against claim 4. Consequently, Applicants assert that claim 4 is patentable over the suggested combination of references.

Rejection Under 35 USC §103(a) Over Yajima, Hefele I, Buell, and Hefele II

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yajima in view of Hefele I, in view of Buell, in further view of U.S. Patent No. 5,569,348 issued to Hefele, hereafter, "Hefele II". Applicants respectfully traverse the rejection by the Office.

Applicants assert that there is no motivation to combine Yajima and Hefele I. For all of the reasons provided above, with regard to the rejection of claims 1, 2, 3, and 11, there is no motivation to combine Yajima and Hefele I. Additionally, for the reasons presented above, with regard to claims 1, 2, 3, and 11, there is no motivation to combine Hefele I with Buell. At least for all of the reasons presented heretofore, with regard to the rejection of claims 1, 2, 3, and 11, and because claim 7 depends from claims 1,

Applicants assert that a *prima facie* case of obviousness has not been established against claim 7.

Rejection Under 35 USC §103(a) Over Yajima, Hefele I, Buell, and Kaylor et al.

Claims 10, 12, and 13, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yajima in view of Hefele I and Buell and in further view of U.S. Patent Application Publication No. 2003/0138570 filed on behalf of Kaylor et al., hereafter, "Kaylor". Applicants respectfully traverse the rejection by the Examiner.

First, Applicants assert that there is no motivation to combine Yajima and Hefele I. For all of the reasons provided above, with regard to the rejection of claims 1, 2, 3, and 11, there is no motivation to combine Yajima and Hefele I. Additionally, for the reasons presented above, with regard to claims 1, 2, 3, and 11, there is no motivation to combine Hefele I with Buell.

Second, there is no motivation to combine Kaylor with Hefele I. As stated previously, Hefele I teaches the application of an adhesive powder to the outer surface of a textile.

Kaylor teaches a "process for the manufacture of diagnostic biosensor films such as diffraction-based diagnostic film." (Abstract). Kaylor further teaches that "[t]he present invention is directed to gravure printing of analyte-specific receptors onto a film substrate." ([0030]). Kaylor also teaches that a "receptor is printed onto the substrate via a receptor solution using a gravure process." ([0040]). In contrast to the process of Hefele I, Kaylor further teaches that "[i]n preparing the receptor solution, the receptor is suspended in a suitable carrier fluid that does not alter the ability of the receptor to bind to both the substrate and the analyte." ([0040]).

Because Hefele I teaches the application of powdered adhesive to an outer surface of a textile and because Kaylor teaches the application of a fluid receptor solution to a substrate, one of ordinary skill in the art would be dissuaded from combining the teachings of Hefele I and Kaylor.

For the foregoing reasons Applicants assert that a *prima facie* case of obviousness has not been established against claims 10, 12, and 13. Consequently, Applicants assert that claims 10, 12, and 13, are patentable over the suggested combination of references.

Rejection Under 35 USC §103(a) Over Yajima, Hefele I, Buell, Hefele II and Datta et al.

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yajima in view of Hefele I, Buell, Hefele II, and in further view of U.S. Patent No. 5,695,376 issued to Datta et al., hereafter, "Datta". Applicants respectfully traverse the rejection by the Examiner.

Applicants assert that there is no motivation to combine Yajima and Hefele I. For all of the reasons provided above, with regard to the rejection of claims 1, 2, 3, and 11, there is no motivation to combine Yajima and Hefele I. Additionally, for the reasons presented above, with regard to claims 1, 2, 3, and 11, there is no motivation to combine Hefele I with Buell. At least for all of the reasons presented heretofore, with regard to the rejection of claims 1, 2, 3, and 11, and because claim 14 depends from claims 1, Applicants assert that a *prima facie* case of obviousness has not been established against claim 14.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a). Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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